

REMARKS

This amendment is responsive to the Office Action dated October 9, 2007 and received in this application. In the amendment, claims 15, 18 and 21 have been amended, and claims 15-23 remain pending for consideration. Applicant respectfully requests reconsideration and allowance of the pending claims.

Applicant confirms receipt of the restriction requirement as well as the election of Group II, claims 15-23, without traverse. Claims 1-14 have been withdrawn from consideration without prejudice or disclaimer. Applicant also reserves the right of rejoinder upon the allowance of a generic or linking claim.

Claims 15, 18 and 21 have been rejected under 35 U.S.C. § 112, ¶2 as being indefinite for failing to distinctly claim what Applicant regards as the invention. Specifically, the Action objects to the term “its” as not having literal antecedent basis. Applicant has amended claims 15, 18 and 21 to provide literal antecedent basis, and thus respectfully requests reconsideration and withdrawal of these grounds of rejection.

Claims 15-23 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Pat. No. 6,275,850 to Beyda et al. (“Beyda”). This rejection is traversed.

Claim 15 has been amended and now recites: *[a] method for restoring electronic mail messages to a mail server, the method comprising:*

determining that an electronic mail message addressed to a particular user is resident at a mail server;

receiving the electronic mail message at a mail client from the mail server pursuant to an electronic mail downloading procedure that entails deleting the electronic mail message from the mail server;

receiving a request to restore the electronic mail message on the mail server following a completion of the electronic mail downloading procedure; and

restoring the electronic mail message as though the electronic mail message had not been downloaded from the mail server in response to receiving the request.

These claimed features are neither disclosed nor suggested by Beyda. Beyda discloses techniques for managing attachments to electronic messages. Beyda discloses that attached files satisfying a prescribed requirement are automatically downloaded from the server to a user's client device. Examples of prescribed requirements include maximum file size, download time, approved file formats, and approved senders. Also, when forwarding electronic messages with attached files, only the attached files that have been modified are uploaded from the client device to the server.

Applicant respectfully submits that Beyda is clearly distinct from Applicant's claimed invention. Beyda deals with the management of attachments. There is no mention of the downloading messages and restoring such messages on the server in any fashion whatsoever.

In any event, even if one were to inappropriately view the attachment as the "electronic mail message," there is still no deletion and restoration of the attachment. Rather, in Beyda, the attachment remains at the local server. When a message is forwarded with an unchanged attachment, that unchanged attachment is simply affixed to the forwarded message (this is believed to be ordinary e-mail forwarding). This procedure is in no way restoration of an electronic mail message.

In another process of Beyda, when a user forwards an electronic message with a modified attachment, the modified attachment is uploaded to the server as part of the forwarded message. First, it should be noted that forwarded messages are different messages, not restored messages. Also, when an attachment is modified, Beyda describes it as a different file altogether. That different file is uploaded to the server when a person forwards a message with the modified attachment.

Applicant submits that Beyda merely describes typical e-mail forwarding and has nothing to do with Applicant's claimed invention, which involves restoration of electronic mail messages on the mail server after a user has received the message at a mail client from the mail server.

With specific reference to the claims, there are thus various features that are clearly not disclosed or suggested by Beyda. In particular, there is no description of (1) *receiving the electronic mail message at a mail client from the mail server pursuant to an electronic mail downloading procedure that entails deleting the electronic mail message from the mail server*; (2) *receiving a request to restore the electronic mail message on the mail server following a completion of the electronic mail downloading procedure*; and (3) *restoring the electronic mail message as though the electronic mail message had not been downloaded from the mail server in response to receiving the request*.

With regard to “*receiving the electronic mail message at a mail client from the mail server pursuant to an electronic mail downloading procedure that entails deleting the electronic mail message from the mail server*,” the Action alleges that column 7, lines 7-60 and column 8, lines 27-34 describe such a feature. However, a review of these passages merely reiterates what is stated above. The first passage describes FIG. 3, elements 48-52, which pertain to transmitting e-mail having an attachment from a remote device to a local server and then accessing such an e-mail by a receiving party, wherein the attached file is automatically downloaded depending upon filter conditions.

There is no mention whatsoever of the type of procedure wherein the electronic mail message is deleted from the mail server when the e-mail is received at the mail client. However, even if one assumes that these procedures exist (although this is not described in Beyda), Beyda also clearly fails to disclose or suggest the remaining claim elements.

First, there is no disclosure or suggestion in Beyda of “*receiving a request to restore the electronic mail message on the mail server following a completion of the electronic mail*

downloading procedure,” as claimed by Applicant. The Action refers to column 8, lines 40-47 in this regard. However, this passage merely reinforces the clear distinctions between the claimed invention and the Beyda reference. This passage describes how, when a user seeks to forward a message with an attachment, but the attachment has not been modified, the forwarded message is transmitted to the local server without the attachment. There is no mention of any kind about receiving a request to restore the previously received e-mail message on the mail server.

Additionally, even under the distorted and inappropriate view that the attachment is the “electronic mail message,” all this passage confirms is that the attachment was never deleted from the mail server. That is, when the user forwards a message with the attachment unchanged, there is no uploading of the attachment because the attachment is already on the mail server.

Still further, there is also clearly no disclosure or suggestion of “*restoring the electronic mail message as though the electronic mail message had not been downloaded from the mail server in response to receiving the request,*” as claimed by Applicant. There is simply no mention whatsoever regarding restoration of downloaded electronic mail messages in even a general sense in the Beyda reference. The relied upon passage (column 8, lines 45-55) makes no mention of message restoration and merely describes how, according to Beyda’s technique, the attachment already stored at the local server is affixed to a message that has been forwarded.

The features of Applicant’s claim 1 are thus distinct from Beyda for various reasons, so Beyda cannot reasonably be concluded as anticipating what is claimed therein. For reasons similar to those provided regarding claim 1, Beyda also fails to disclose or suggest independent claims 15 and 18. The dependent claims respectively depend from the independent claims and thus incorporate these distinct features as well as their separately recited patentably distinct features.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 15-23 under 35 U.S.C. § 102(b) as being anticipated by Beyda.

In view of the foregoing arguments, all claims are believed to be in condition for allowance. If any further issues remain, the Examiner is invited to telephone the undersigned to resolve them.

This response is believed to be a complete response to the Office Action. However, Applicant reserves the right to set forth further arguments supporting the patentability of their claims, including the separate patentability of the dependent claims not explicitly addressed herein, in future papers. Further, for any instances in which the Examiner took Official Notice in the Office Action, Applicant expressly does not acquiesce to the taking of Official Notice, and respectfully request that the Examiner provide an affidavit to support the Official Notice taken in the next Office Action, as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03.

If any fees are due during the prosecution of this application, please charge our Deposit Account No. 18-0013, from which the undersigned is authorized to draw, under Order No. AST-0001.

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Respectfully submitted,

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